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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,215	11/29/2000	Kazuo Sasaki	1405.1028/JDH	6349
21171	7590	12/22/2005	EXAMINER	
STAAS & HALSEY LLP			VU, THONG H	
SUITE 700			ART UNIT	PAPER NUMBER
1201 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20005			2142	
DATE MAILED: 12/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/725,215	SASAKI ET AL.
Examiner	Art Unit	
Thong H. Vu	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 09 December 2005.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 2-8 and 10-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 2-8 and 10-13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

1. Claims 2-8,10-13 are pending. Claims 10-12 have been amended. Thus the Final action is appropriate.

***Response to Arguments***

2. Amendment filed on 12/09/05 has been entered. Applicant's arguments with respect to claims 2-8,10-13 have been considered but are moot in view of the new ground(s) of rejection.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-8,10-13 are rejected under the judicially created doctrine of double patenting over claim1-20 of U. S. Patent No. 6,735,615 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Both inventions disclose a Chat system monitors, notifies (i.e.: message string or notification) and displays the changed of status table to the user.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8,10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudjonsson et al [Gudjonsson 6,564,261 B1] in view of Morse et al [Morse 5,802,296].

4. As per claim 10, Gudjonsson discloses a user-status setting method in which a user terminal can send, receive, and display a user status and a character message on at least one virtual space shared on a network [Gudjonsson, chat session, col 1 lines

32-38; message string, col 22 lines 40-42; user status, col 3 lines 38-45] the method comprising:

storing a plurality of user-status-selection tables [Gudjonsson, the buddy list, col 3 lines 37-45; database, col 12 lines 42-54; selecting user from the list, col 12 lines 55-col 13 line 4];

reading out the user-status-selection table of a virtual space in which a user terminal participates when the user terminal has participated in a plurality of virtual spaces [Gudjonsson, the buddy list, user' status(es) changes, col 3 lines 37-45; col 11 line 52; select contact from the list, col 12 lines 55-67];

displaying on the user terminal the list of the selectable user statuses for each virtual space based on the read-out user-status-selection table [Gudjonsson, online statuses, col 12 lines 5-15];

setting a user status which was selected from the list of selectable user statuses for each virtual space in which the user has participated [Gudjonsson, setting on line status, col 26 lines 30-37];

sending to each virtual space the set user status, receiving from each virtual space the set user status, and displaying the set user status for each virtual space [Gudjonsson, online statuses, defining folder, different display modes, col 12 lines 5-15].

However Gudjonsson does not explicitly detail "including a user status options from which a user selects his /her own status for each virtual space ; "

It was well-known in the art that a computer network creates a virtual world in which the user can interact with each other [Morse, abstract] including a status menu (or

status option) from which a user can select or maintains a list in the virtual space or virtual object /avatar [Morse, col 4 lines 15-28]

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the status menu wherein the user can selects his/her own list for each virtual objects as taught by Morse into the Gudjonsson's apparatus in order to utilize the selecting list. Doing so would provide an easy way to advertise availability of other users to communicate [Gudjonsson, col 2 lines 30-43].

5. Claims 11,12 contain the similar limitations set forth of apparatus claim 10.

Therefore, claims 11,12 are rejected for the similar rationale set forth in claim 10.

6. As per claim 2, Gudjonsson-Morse disclose each user status is associated with an attribute of a user who is permitted to select the user status in the user status selection tables [Gudjonsson, user registered, col 14 lines 1-10].

7. As per claim 3, Gudjonsson-Morse disclose the user terminal stores a common table in which prescribed user statuses are registered, and sets the common table as a user status selection table for a virtual space in which user terminals participate, if no user status selection table is stored for the virtual space [Gudjonsson, by default, col 8 lines 47-65; col 35 lines 37-45; col 36 lines 7-21].

8. As per claim 4, Gudjonsson-Morse disclose the setting of a user status selection table by a user is accepted [Gudjonsson, setting on line status, col 26 lines 30-37].

9. As per claim 5, Gudjonsson-Morse disclose said user terminal can display the user statuses with symbols, the user statuses and the symbols are correlative registered in a user status selection table, and a status of another user sharing a virtual space is displayed with a symbol relating to the user status in a user status selection table [Gudjonsson, symbols, col 29 lines 1-23].

10. As per claim 6, Gudjonsson-Morse disclose a list of user statuses registered in an obtained status table is displayed independently for each virtual space in which user terminals participate, selection of any user statuses on the list is accepted for each virtual space, and a user status is set for each virtual space.

11. As per claim 7, Gudjonsson-Morse disclose a computer-readable recording medium having a status setting module [Gudjonsson, database, col 12 lines 42-54].

12. As per claim 8, Gudjonsson-Morse disclose a transmission medium transmitting a status setting module [Gudjonsson, communication medium, col 16 lines 48-67].

13. As per claim 13, Gudjonsson-Morse disclose the user status includes a string of characters entered by the user [Gudjonsson, string, col 35 lines 13-37; character, Table 4, col 29 lines 1-23].

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thong Vu*  
*Primary Examiner*  
*Art Unit 2142*

